

II Remarks

The undersigned has been recently notified by the German patent attorney who handles the parent German application, priority of which is claimed by the present case, that the inventor in the present case, Professor Dr. Gunther O. Schenck died on March 25, 2003 after issuance of the Outstanding Final Office Action.

The undersigned recognizes that the Power of Attorney in the present application has been terminated under MPEP 409.01. However, the undersigned while acting in a representative capacity under Rule 34 is entitled to sign this Response.

The undersigned wishes to thank Primary Examiner Cephia D. Toomer for the courtesy extended to him during the numerous conferences preceding to preparation and filing of this Response. Upon reviewing the amended version of independent claim 22, it has been indicated by the Examiner that this claim is allowable. Claims 23-27 are dependable upon allowable independent claim 22, do not contain independently patentable subject matter and therefore also should be allowable.

Independent claim 14 has been amended in the manner previously approved by the Examiner with respect to the independent claim 22 and also should be allowable. Claims

15-20 are dependent upon the allowable claim 14, do not contain independently patentable subject matter and also should be allowable.

As to the independent claim 13, it has been also amended in the manner previously approved by the Examiner with respect to the independent claim 22. Claim 13 has been further amended and clarified with respect to the “industrial use” language. This language has been substituted by the expression “forming industrial products for use in technical fields” which is fully supported by the last paragraph of the Specification (see page 6, lines 17, 18). It is respectfully submitted that claim 13 containing this language should be entered into the application since it is supported by the originally filed application and does not change the substance of the claim. Thus, claim 13 should be allowable. Claims 10 and 11 are dependent upon allowable claim 13 and also should be allowable.

In the Outstanding Office Action claims 1, 2 and 5-28 have been rejected under 35 U.S.C. 112, first paragraph in view of the arguments provided by the Examiner it is respectfully considered that this rejection of claims is moot in view of the amendment of the claims provided in the Response.

Claim 1 has been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,318,710 to Pilipski. It is respectfully considered that the rejection of claim 1 is moot in view of the cancellation of this claim in the Response.

Applicant respectfully disagrees with the following Examiner's statement with respect to the Pilipski reference provided in the Office Action: "Pilipski tests a portion of the charcoal to determine its heat of combustion and the rest is stored for commercial sale." (underlining is provided). In this respect, the issue is whether the underlined part of the Examiner's statement is disclosed by the Pilipski reference. To illustrate the position of the Applicant the following portions of the Pilipski reference are brought to the attention of the Examiner:

Col. 1, line 42: "usable as a fuel or for any other known purpose."

Lines 48-54: "... The fact that petroleum-derived hydrocarbon fuels are becoming increasingly scarce and much more expensive lends particular significance to this alternative source of fuel. Moreover, this source, which is derived from wood and other organic matter, is renewable and therefore effectively inexhaustible."

Col. 3, lines 17-20: "The charcoal produced by the action of anhydrous hydrogen chloride is soft and easily ground in a fine powder. This charcoal can be ground, packed, caked, or briquetted for each of transportation ..." (underlining is provided).

It is respectfully considered that, in the Pilipski reference, the above citations are the statements which relate to processes by which the charcoal is treated after production. The processes disclosed in the Pilipski reference thus can be summarized as follows: Substituting hydrocarbon fuels by charcoal and generating energy by combustion of charcoal; grinding, packing, caking, briquetting charcoal; transporting ground, packed, caked or briquetted charcoal; and determining the heat of combustion of the charcoal.

Consequently, it is respectfully considered that Pilipski reference does not disclose the following processes: Bunkering charcoal for extended periods of time; as a result of bunkering the charcoal for the extended period of time, removing CO₂ from the atmosphere due to preventing charcoal combustion during the extended bunkering time.

As explained in the application, this reduction in the atmospheric CO₂ level is resulted from the fact that the rate of assimilation of CO₂ by the related forested area is maintained substantially at the same level during the extended bunkering time.

Thus, it should be evident that the Examiner's position that "... the rest [of the charcoal] is stored for commercial..." has no recognizable basis in the Pilipsky reference. Moreover, significantly the step of bunkering the charcoal for an extended period of time, so as to thereby reduce the atmospheric CO₂ level during that extended period of time, is

not “other known purpose” for using charcoal, and is not obvious from the prior art of record.

Furthermore, it should be also evident from the previous citations that the Pilipski reference clearly intends to use the entire amount of charcoal for combustion. Contrary to the instant application, it does not consider the emission of CO₂ into the atmosphere and the concomitant greenhouse effect generated thereby. Thus, there is a substantial difference between the application and the Pilipski reference with respect not only of the specific matter recited in the claims, but also with respect to the objects of invention and the manner in which such objects are achieved. In fact, the Pilipski reference is directed to utilizing charcoal as a fuel and neglects the CO₂ emission generated thereby. On the other hand, the invention is directed to removal of the charcoal for an extended period of time from any CO₂ generating process in order to thereby reduce the CO₂ content of the atmosphere. This is the reason why the invention, as represented by the claims of record, is patentable over the Pilipski reference.

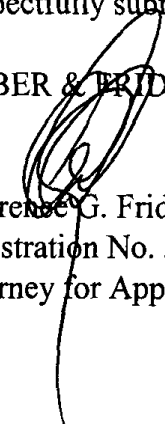
Thus, applicant respectfully considers that all claims currently of record in the application should be allowable. Withdrawal of the Examiner’s rejection and allowance of all claims currently of record are therefore respectfully requested.

The undersigned respectfully petitions for one month extension of time. A separate Petition and the appropriate check in the amount of \$55.00 accompany this Response.

July 21, 2003

Respectfully submitted,

SILBER & FRIDMAN



Lawrence G. Fridman,
Registration No. 31,615
Attorney for Applicant

66 Mount Prospect Avenue
Clifton, New Jersey 07013-1918
Telephone (973) 779-2580
Fax (973) 779-4473

PTORESP03_217